REMARKS

I. Claim Rejection – 35 U.S.C. §103(a)

Claims 1, 3-20 and 23-27 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Makino et al. (EP 0237 200) ("Makino") in view of Okada et al. (JP402237918) or US 5,776,489 to Preston et al.

A. Makino does not disclose or suggest a delayed release formulation, wherein the dosage form is not enteric coated.

The claimed invention is directed to a ***delayed release*** oral dosage form wherein the dosage form is not enteric coated.

The Examiner alleges that Makino discloses a dosage form having an enteric coating and providing a delayed release. In this regard, the Examiner relies on the publication disclosed by Applicants, i.e., http://australianprescriber.com/magazines/vol22no4/oral.htm ("Australian Prescriber"). Furthermore, the Examiner notes that Makino discloses water-insoluble polymers, e.g., ethyl cellulose, as a possible coating agent. Thus, the Examiner concludes that Makino suggests a coated composition giving the same release profile as the dosage form of the claimed invention. The prior art rejection of record has been maintained.

For the following reasons, Applicants repeat that the cited prior art does not suggest the claimed invention and, therefore, the Examiner has failed to establish a *prima facie* case of obviousness.

As disclosed at page 8, lines 36-37, the primary reference to Makino discloses the following three purposes for coating tablets and granules:

(1) masking of the taste;

(2) providing them with enteric release property; or

(3) providing them with a sustained release property.

Makino purposes (1) and (3), above, i.e., masking taste and providing a sustained release profile, respectively, do not suggest the purpose of the claimed invention which is to provide an oral dosage form having a delayed release profile wherein the dosage form is not enteric coated.

Makino purpose (2) relates to an enteric release profile. Such a release profile is exhibited by Examples 7 and 9 which show enteric coated granules. Although the publication Australian Prescriber indicates such an enteric coated product may give a delayed release profile, the claimed invention is distinguishable over such enteric-coated products since the claimed invention expressly excludes an enteric coating.

To accomplish purposes (1), (2) and (3), above, Makino discloses various coating agents at page 8, lines 37-41. One such coating agent is ethyl cellulose. In other words, Makino discloses that ethyl cellulose can be used to coat a tablet or granule for the purpose of (1) masking taste, (2) providing an enteric release property or (3) providing a sustained release property. It is worth repeating, that Makino purposes (1) and (3), i.e., masking taste and providing a sustained release profile, respectively, do not suggest the purpose of the claimed invention which is to provide an oral dosage form having a delayed release profile wherein the dosage form is not enteric coated.

With respect to Makino purpose (2), i.e., providing an enteric release property, Makino suggests the use of water-insoluble polymers to prepare enteric-coated products. Again, such products are demonstrated by Examples 7 and 9 which show granules having an enteric coating comprising Eudragit which is a known water-insoluble film former. The publication Australian Prescriber indicates that such enteric coated products may give a delayed release profile. However, there is no suggestion that an oral dosage form giving a delayed release profile can be prepared ***without*** an enteric coating.

In conclusion, Applicants submit the following:

- Makino discloses three purposes for coating tablets and granules: (1) masking taste; (2) providing an enteric release profile; and (3) providing a sustained release profile.
- To achieve any one of purpose (1), (2) or (3), Makino discloses the application of a coating agent such as a water-insoluble polymer, e.g., ethyl cellulose.
- Makino discloses granules produced with an enteric coating comprising Eudragit, i.e., a known water-insoluble film former (See Examples 7 and 9).
- Australian Prescriber discloses that enteric-coated products, such as those disclosed by Makino, may give a delayed release.
- The purpose of the claimed invention, i.e., to provide an oral dosage form having a delayed release ***without*** an enteric coating, is distinguishable from purposes (1), (2) and (3) of Makino.
- It is not a purpose of Makino and, therefore, there is no suggestion by Makino to prepare a delayed release dosage form that is not enteric coated.

For all of the foregoing reasons, Applicant s submit that Makino, whether taken alone or in combination with the secondary references to Okada et al. (JP402237918) or US 5,776,489 to Preston et al., does not suggest the claimed invention. Thus, the Examiner has failed to establish a *prima facie* case of obviousness.

B. <u>The claimed invention is illustrated by and not limited to the Examples</u>.

Applicants further submit that they should not be required to limit the claims to the release profile shown in Example 4. By definition, the claimed invention is directed to an oral dosage form providing a delayed release profile. As used in the claims, the expression "delayed release" profile has a meaning that is understood and accepted by those skilled in the art. Example 4 merely illustrates and substantiates the release profile of the claimed invention and is not intended to limit the scope of the invention.

C. The prior art submitted by Applicants contains technical information verifying that it was inconceivable to prepare oral <u>formulations of omeprazole without an enteric coating</u>.

Applicants are appreciative of the Examiner's recommendation that Applicants submit a declaration supported by technical data showing that it was unconceivable to prepare an oral formulation of the acid labile substance omeprazole without an enteric coating. However, Applicants submit that a declaration should not be required in view of the technical data provided by the prior art publication previously submitted by Application as part of their communication mailed 27 February 2003.

As of the priority date of Makino (13 February 1986), the prior art in 1985 (Pilbrant et

al.) provided that an oral dosage form of omeprazole having no enteric coating was not feasible as a dosage form having any pharmacological effect. The prior art in 1986 (EP 0 247 983) provided that an enteric coating layer is necessary to ensure that the active ingredient is protected and transferred in an intact form to that part of the GI tract where the pH is near neutral and where rapid absorption can occur.

For all of the foregoing reasons, withdrawal of the §103 rejection is requested.

CONCLUSION

Applicants have made a good faith attempt to respond to the Office Action. It is respectfully submitted that claims 1, 3-20 and 23-27 are in condition for allowance, which action is earnestly solicited.

Any fees due in connection with this response should be charged to Deposit Account No. 23-1703.

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Respectfully submitted,

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